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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,281	01/16/2002	David M. Dean	AD6786USNA	7034

23906 7590 03/25/2004

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WILMINGTON, DE 19805

EXAMINER

ACQUAH, SAMUEL A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/050,281

Applicant(s)

DEAN, DAVID M.

Examiner

SAMUEL A. ACQUAH

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/18/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's arguments filed 12/22/03 have been fully considered but they are not persuasive. See the explanations below.

3. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP6122803.

The disclosures of the cited prior art are as discussed in the previous Office Action. It is the Applicant's position that this prior art is different because "it does not mention that paramagnetic properties can be imparted to a composition by inclusion of rare earth elements". It is the Examiner's position that Applicant's argument is not convincing because the prior art clearly discloses a transparent composition comprising a non-ethylenic containing polymer complexed with an amount of one or more rare earth metal ions. The amount of the rare earth ions is in the range of 0.001 to 35 pbw. Patentee further discloses that the composition has **various properties**, including selective absorptivity and emissivity of ionizing radiation and electromagnetic radiation originating from rare-earth elements (emphasis added). Thus, patentee clearly indicates that the presence of the rare-earth elements in the composition imparts various properties, including those mentioned. Applicant is further reminded that the disclosure of a new property of a known composition does not patentably distinguish over the prior art composition. In the case herein, the prior art discloses the same composition with the indicated elements in the same amounts, thus the claimed property of paramagnetism

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would be inherent in the prior art composition. Applicant claims "a sufficient amount of the rare-earth element". There is no specific number recited, but the prior art does disclose amounts of said elements in amounts including those claimed. For example, the prior art discloses that the amount of the element should be in the range 0.001-35 pbw, and shows at least one example (Working Example 8) wherein the amount is 8 pbw. This amount is clearly "sufficient" to impart the claimed property.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6122803.

The disclosure of the cited prior art is as discussed above. The claims herein are drawn to compositions comprising the rare-earth element in amounts greater than 9 pbw. Patentee clearly teaches that the amount of the element ions may be in the range of 0.001 to 35 pbw, and that this range imparts various properties to the composition. It is the Examiner's position that the claimed composition would have been obvious over the disclosures of the cited prior art, absent a showing of clear and convincing unexpected results.

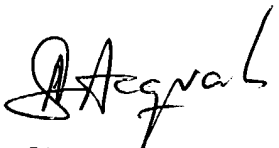
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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL A. ACQUAH whose telephone number is 571-272-1065. The examiner can normally be reached on M-TH, FRIDAYS OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES SEIDLECK can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.A.A.  
03/20/04

  
SAMUEL A. ACQUAH  
PRIMARY EXAMINER  
GROUP 120, 1750